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OPINION AND ORDER OF THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF PENNSYLVANIA

Civil Action Nos. 30984, 34333, 34334, 34483

April 28, 1969

FULLAM, J.

This is a consolidated action for infringement of United States letters of patent number 2,620,938 (hereinafter '938). Defendants seek a declaration of invalidity and non-infringement. Pursuant to Rule 42(b) of Fed. R. Civ.P., the issues of liability for infringement and damages have been separated. Upon review of the trial record, and consideration of the proposed findings of fact and conclusions of law, the Court makes the following:

FINDINGS OF FACT

1. The '938 patent was originally issued to Mr. Charles Jesnig on December 9, 1952. Mr. Jesnig died before trial. Plaintiff Package Devices, Inc. (hereinafter PDI), is now the rightful owner of '938.

2. Plaintiff, PDI is a Pennsylvania corporation, having its principal office in Philadelphia, Pennsylvania.

3. Defendant, Sun Ray Drug Co. is a Pennsylvania corporation, having its principal place of business in Philadelphia, Pennsylvania.

4. Defendant, Owens-Illinois Glass Co. is an Ohio corporation, having a regular and established place of business at Philadelphia, Pennsylvania.

3. Defendant Wyeth Laboratories Division, American Home Products Corp. is a Delaware corporation, having a regular and established place of business in Wynnewood Pennsylvania.

6. Defendant E. J. Kenvette is a New York corporation, having a regular and established place of business at Philadelphia, Pennsylvania.

7. Owens-Illinois Glass Company (hereinafter Owens-Illinois) is a manufacturer of the accused structures, and Sun Ray Drug Co., Wyeth Laboratories, and E. J. Kenvette Inc. have marketed products in these structures.

8. The subject matter of the '938 patent is the design of a container finish, particularly the neck ring, and the design of an elastomer container cap. Products such as aspirin are marketed in containers with the so-called snap tops which are alleged to infringe '938.

9. The inventor, Mr. Jesnig, conceived his invention in January of 1947, while engaged in research to develop methods of vacuumizing tin can containers. He made a polyethylene cap to fit over a model with a 30°/30° conical finish on February 4, 1947.

10. At some time before May 12, 1948, Mr. Jesnig was requested by Mr. Nack, an employee of Sharpe & Dohme, Inc., to endeavor to develop a suitable closure for serum vials which the Wheaton Glass Co. was currently manufacturing and supplying to Sharpe & Dohme, Inc.

11. Subsequent to the meeting with Mr. Nack, but prior to May 12, 1948, Mr. Jesnig prepared a lucite model of a closure and a neck finish which reflected the concepts incorporated in the tin-can experiment of February 4, 1947, and which was essentially the same as the '938 patent.

12. Mr. Wheaton, of the Wheaton Glass Co. (hereinafter Wheaton), found Jesnig's model acceptable, but for expediency decided to use the closure with a standard rounded finish that was presently available.

13. After the meeting with Mr. Wheaton, Mr. Jesnig began the process of preparing a patent application con-

cerning the use of his closure with the standard rounded finish which Mr. Wheaton had decided to use. The application was filed on May 12, 1948, and United States Letters of Patent No. 2,587,327 (hereinafter '327) was issued on February 26, 1952.

14. After his original decision to use a standard rounded finish, Wheaton developed a glass finish with a 30°/30° conical surface. This new finish was designed to imitate the finish of the original model which Jenning had shown to Mr. Wheaton, and production drawings were in existence on October 22, 1948. Production of bottles with the new finish was underway by February 1949.

15. On January 24, 1949, PDI, the assignee from Jenning of patent application No. 26687 (this application matured into the '327 patent) entered into a licensing agreement with Wheaton. The subject of this agreement was the closure or the snap-cap that was to be used with the standard rounded finish.

16. Bristol Myers, a vendee of Wheaton, forwarded Wheaton's production drawings of the 30°/30° conical neck ring to Owens-Illinois some time just prior to July 5, 1949. Owens-Illinois manufactured bottles in accord with the Wheaton drawing in December of 1949.

17. The prosecution of the '938 patent was initiated on September 12, 1949, and the patent was issued on December 9, 1952. Ten claims were contained in the original application. Shortly thereafter, November 22, 1949, Claims 11 and 13 were added. These were designed to elucidate the importance of the neck ring and the interaction of the neck ring and cap. All thirteen claims were rejected by the Examiner on January 27, 1950, on the basis of prior art. The term "apex" was used in Claims 11 and 12 to describe the juncture of the outward and inward tapers of the container ring. No definition of apex was contained in these claims; however, the application described the apex as a "peak or line."

18. In response to the Examiner's action of January 27, 1950, amendments were made by a letter dated May

31, 1950. These amended Claims, 1 through 13, were again rejected on the basis of prior art.

19. By letter dated May 9, 1951, all thirteen claims were cancelled and Claims 14 through 18 were added. On July 3, 1951, Claims 19 through 25 were added and Claims 14 through 18 were cancelled without any action being taken by the Examiner. The term "apex" was again used to describe the juncture point. The Examiner rejected Claims 19 through 25 on July 31, 1951. His basis, again, was prior art.

20. On January 25, 1952, plaintiff cancelled his prior claims and added Claims 26 through 28. An affidavit by Dr. Mauchly accompanied these amendments. The language "steep annular apex" was used in these claims. In the statement supporting these amendments, Mr. Jesnig described the neck ring as "two flats coming up to a steep apex or knife edge which acts as a fulcrum up to a steep apex or knife edge which acts as a fulcrum. . . ." (D.E. 71 p. 58) On February 21, 1952, Claims 26 and 28 were rejected on the basis of prior art, but 27 was allowed if the term "steep" was eliminated. The Examiner observed: "The word 'steep' in [the three claims] is objected to as being meaningless and indefinite as used in these claims." (D.E. 71 p. 82)

21. On February 21, 1952, Mr. Jesnig, apparently unaware of the Examiner's action of that date, cancelled all previous claims and substituted Claims 29 through 31. In these he used the language "annular peak line" to refer to the juncture of the inward and outward tapers. In the accompanying statement, Mr. Jesnig emphasized the importance of the design of the neck ring:

> "The neck ring should make a rapid transition from one of these conical surfaces to the other and at an apex which is essentially a circular edge . . . The object here is to minimize the possible position in which the cap could remain in a state of neutral equilibrium instead of either sealing properly or coming back off." (D.E. 71 p. 89)

22. On August 19, 1952, after Jesnig became aware of the Examiner's action of February 21, 1952, all prior claims were cancelled and Claims 32 through 34 were added. The claim at issue in the present litigation was denominated as Claim 33 of these amendments. Claim 33 was formerly Claim 29 and Claim 29 was formerly 26. Claim 26 was originally rejected by the Examiner's action of February 21, 1951, on the basis of prior art. The term "steep" was deleted in accord with the Examiner's observation that the term was "meaningless and indefinite." A notice of allowance was then issued on September 19, 1952.

23. Claim 2 of '938, which is at issue in this action, reads as follows:

In a container,

A a vessel having a rigid neck provided with a neck opening and

B having an external annular neck ring on the neck

C which has a conical annular surface tapering abruptly outwardly from the end of the neck ring adjoining the neck opening and

D a reverse conical annular surface tapering abruptly inwardly on the side of the neck ring remote from the neck opening,

E the conical annular surfaces meeting in an annular apex which has the largest diameter of the cap area of the neck ring,

F and a resilient elastomer cap body

G having an end portion which extends over, closes and seals against the otherwise open end of the neck and

H having a continuous annular flange portion integral with the end portion,

I the flange portion having a larger diameter than the conical annular surface of the neck ring, and

J the flange portion having an inwardly extend-

ing and downwardly converging continuous annular rim which engages around and grips the reverse conical annular surface of the neck ring when the cap is in place on the neck ring.

K the inner annular rim surface conforming with the reverse conical surface for sealing engagement therebetween.

L the rim being so spaced relative to the cap end portion that when the cap is in place on the neck ring, the cap engages the neck ring at the end of the neck adjoining the neck opening and on the reverse conical surface.

M the aforesaid structure of the neck ring cooperating with the axial resilience of the cap flange to store energy during the first stages of cap application, which energy is released suddenly as the rim attains the apex so as to cause the rim to pass completely over the apex and the cap attains its final sealing position and to maintain said flange portion under substantial axial tension in said cap position.

24. During the prosecution of this application, seventeen patents were cited as prior art by the Examiner.

25. Of those cited by the Examiner, defendants now rely on the Stewart, Jesnig '327, and the British patents.

26. The Stewart patent, Patent No. 2,109,805, was issued on March 1, 1938. The subject matter of the patent is a metal pry-off closure to be applied to a glass bottle. Locking of the metal cap is effectuated by circumferentially spaced inwardly projecting lugs. The neck ring is a circumferentially continuous bead which has a downward and outward slope of 45°, a radius of 1/32 of an inch, and a downward and inward slope of 30°. The upper surface of the bead is considerably longer than the lower surface. After the lugs have traversed the upper surface of the bead and the radius, the lugs engage the lower surface of the bead. A gasket is used in order to create a seal at the mouth of the bottle.

27. British Patent No. 484,161 was issued on April 29, 1938. A conical neck finish is used on the bottle, and the juncture of the upper and lower surfaces is specified to be as sharp as possible. A metal cap with packing in the cap skirt is designed to fit onto the upper and lower surfaces of the neck finish. Another gasket is used in the top of the closure to form a seal between the cap and the mouth of the bottle.

28. The Jesnig patent, No. 2,587,327, was issued on February 26, 1952. The subject matter of the patent is a resilient plastic cap to be utilized with a standard rounded finish. The skirt of the cap has a circumferential annular bead which is applied over the finish, and depending upon design, either engages the lower surface of the rounded finish or the wall of the container itself. The skirt of the cap has a cut-out groove that separates the bead portion of the skirt from the outside portion of the skirt. This allows the bead portion of the skirt to expand while the outside portion is stable. Engagement is made between the cap and the mouth of the bottle. By using this design a snapping action was created when the cap was applied to the bottle.

29. Defendants also cite the Dunfee, Goebel, and Randlett patents. These were not cited by the Examiner.

30. The Dunfee patent, Patent No. 1,175,054, was issued on March 14, 1916. The inventor's purpose was to design a one-piece nipple and closure that could be more securely attached to a nursing bottle. A neck ring with an outwardly-faced "V" shaped conical surface interacts with a "V" shaped internal bead on the skirt of the rubber cap. There is contact between the cap bead and the lower conical surface of the neck ring and with the container wall below the lower conical surface.

31. The Goebel patent, Patent No. 2,063,428, issued on December 8, 1936, concerns a reusable metal cap which can be manually snapped on and off a glass container. The neck ring of the finish originates below the

mouth of the container, and the circumferential bead has an upper surface moving downwardly and outwardly to a radial juncture, and a lower surface moving downwardly and inwardly at a greater angle than the upper surface. The inwardly-facing corrugated skirt of the cap has a slightly smaller diameter than the maximum diameter of the neck finish, in order to insure the engagement of this skirt and the lower conical surface of the neck ring. By using a resilient corrugated skirt with a narrower diameter than the bottle finish, a camming effect is created, and as the cap passes to the lower conical surface a tensioning effect is created; said effect is enhanced by the abrupt angle of the lower surface. An upper seal is effectuated by the use of a gasket in the cap.

32. The Randlett patent, Patent No. 2,576,416, was applied for on June 8, 1948, and issued on November 27, 1951. This invention involves a removable rubber-like snap-cap with a perforated top for dispensing seasonings. A glass container is fitted with the removable dispensing cap, and a standard threaded closure is applied over this dispensing cap. There is a slight radius at the mouth of the container, and just below this point there is an inwardly-faced "V" shaped groove. The dispensing cap has a skirt with a "V" shaped bead which is received into the container's "V" shaped groove when the cap is applied. Engagement is made between the cap bead and the container groove on the downward and inward surface of the groove.

33. Defendants also cite the Lumelite Cap, an article entitled "Precocious Plastics" in the February 1948 issue of *Modern Plastics*, the combination of the Lumelite Cap and British Patent No. 484,161, the Kitchen Kap and Flexeal Finish, and the Barnby patent application, No. 759,049, filed on July 5, 1947.

34. By December of 1945, the Lumelite Corp. of Pawling, N.Y. was marketing a reusable polyethylene cap [the Lumelite Cap] to be applied to bottles having a

standard crown finish. The diameter of the cap was designed to be smaller than the maximum diameter of the crown finish. After the cap was stretched over the crown finish, the internal circumferential bead of the cap engaged the downward and inward surface of the crown finish. A primary seal was formed between the cap and the bottle mouth, and a secondary seal was formed between the bead of the cap and the lower surface of the crown finish. Small orders for the Lumelite Caps were received as early as December 14, 1945, and sales increased thereafter. One of the main selling features of the cap was the noise of the cap bead snapping over the finish of the bottle.

35. The February 1949 issue of *Modern Plastics* contained an article entitled "Precocious Plastics." This article predicted that one of the largest uses of polyethylene would be in the container closure field, and that Lumelite Corp. was currently marketing a wide variety of polyethylene closures, including the Lumelite Cap.

36. Defendants have also cited a hypothetical combination of the Lumelite Cap and the finish of the British Patent No. 484,161. If the cap and the container finish were dimensionally coordinated, the bead of the Lumelite Cap would move down the upper surface of the neck ring, cross the sharp juncture point of the upper and lower surfaces, and then engage the lower conical surface.

37. By January 1, 1946, Owens-Illinois manufactured and sold a glass container with a Flexeal finish. Customers of Owens-Illinois marketed coffee in these containers. Drawings for a reusable polyethylene cap designed to be used with the Flexeal finish were in existence on April 10, 1947, and said polyethylene caps were manufactured and sold under the trade name Kitchen Kaps by July 1, 1947. Coffee retailers marketed coffee in Flexeal containers with a metal closure, and after the purchaser removed the metal closure the Kitchen Kap was used as its replacement. The skirt of the Kitchen

Kap has a circumferential bead at its lower portion, and the Flexeal finish has a top sealing bead at the mouth and below that a non-continuous annular neck ring. The bead of the Kitchen Kap moves down the 4° angle of the upper surface of the neck ring to the point of maximum diameter, then the bead moves inward on the lower surface of the neck ring, which has a substantially more acute angle than the upper surface. Engagement is made between the cap and the container at the mouth of the container and between the bead of the cap and the lower surface of the neck ring.

38. On July 5, 1947, Herbert Barnby, an employee of Owens-Illinois, filed patent application No. 759,091. This application describes a closure similar to the Kitchen Kap, and the bottle finish of the container was similar to that of Flexeal finish. By June 30, 1949, Barnby claimed that when the cap was applied to the glass finish a hermetic seal would result at the point of engagement of the cap and the mouth of the container, and at the point of engagement of the cap bead and the lower surface of the nick ring.

39. Owens-Illinois was aware of the '938 patent as early as 1954. Subsequently, employees of Owens-Illinois manifested their awareness of the possibility that their products might be alleged to infringe '938.

40. Owens-Illinois accused structures, bottle finishes 1061-C, 1056, and 1058, all have a radius of 1/64 to 1/32 of an inch at the juncture of the upper and lower surfaces of the neck ring.

41. There was a need for improved closures in the pharmaceutical industry in 1948.

42. On August 5, 1954, PDI issued a license to use '938 to Wheaton and agreed to a voluntary dismissal of its pending infringement suit. As consideration, Wheaton agreed to pay $10,000. In addition, Wheaton agreed to pay a 5% royalty on all sales after any final judgment adjudicating '938 valid.

43. On February 10, 1956, PDI granted a license to the West Company of Phoenixville, Pennsylvania, to use the '327 and '938 patents. As consideration, a 5% royalty on all sales was to be paid.

44. On January 25, 1962, PDI granted a license to Armstrong Cork to use '938. PDI also released Armstrong and its customers from any infringement claims which it had against said parties. Twenty thousand dollars was paid as consideration.

45. On August 17, 1962, PDI granted a license to Diamond Glass Co. of Pennsylvania to use '938. PDI also released Diamond and its customers from any infringement claims which it might have against said parties. Seventy-five hundred dollars was paid as consideration.

46. On October 30, 1962, PDI granted a license to Anchor Hocking Glass Corp. to use '938. PDI also released Anchor Hocking and its customers from any infringement claims which it might have against said parties. Fifteen hundred dollars was paid as consideration.

47. On October 30, 1962, PDI granted licenses to Dougherty Brothers Co. to use '327 and '938. A 5% royalty on net proceeds of sales of snap-caps was the agreed consideration.

48. On September 11, 1963, PDI granted licenses to Continental Can Co., Inc. to use '327 and '938. PDI also released Continental and its customers from any infringement claims which it might have against said parties. PDI and Continental also agreed to cooperate in causing a voluntary dismissal of PDI's infringement suit against Continental. Fifteen thousand dollars was paid as consideration.

49. On May 5, 1966, PDI granted a license to Rexpax, a division of Rexall Drug and Chemical Co., to use '938. As consideration, Rexpax agreed to a 5% royalty if gross sales were less than five million units, and 3% if gross sales were over five million units, with a minimum guarantee of $1,000 per year. Rexpax had a unilateral right to cancel on a 30 day notice.

DISCUSSION

The patent claim at issue relates to the design of a container and a cap, and the dimensional interrelationship of these two independent structures. This litigation has been primarily focussed upon the design of the neck ring of the container. In general terms, a cross-section of a neck ring reveals that the ring is comprised of two surfaces, an upper and a lower. The upper surface may be conical or semi-circular in design and it moves from the mouth of the container outwardly and downwardly; conversely, the lower surface moves from the outermost end of the upper surface inwardly and downwardly to the neck wall of the container. An important facet of this action is the design of the juncture point of these two surfaces. Two possibilities exist: the juncture point may be a radial surface, or merely a straight line juncture similar to the point at which two sides of a triangle meet.

It is the defendants' position that the plaintiff's patent is invalid because it fails to meet the requirements of sections 102(a), (b), 103 and 112 of the Patent Act, 35 U.S.C. §§102(a), (b), 103, 112. Each of the defendants' defenses will be considered separately.

Section 112

Section 112[1] reflects a congressional attempt to accommodate the sometimes conflicting policies of the

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[1] "*Specification*

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. . . ."

patent law: "[T]o protect the patentee and encourage experimentation in the area not covered by the patent." *Corning Glass Works v. Anchor Hocking Glass Corp.*, 374 F. 2d 473, 477 (3d Cir. 1967). Mr. Justice Reed articulated the purposes of section 112 in *General Electric Corp. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1937):

> "The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent be dedicated ultimately to the public. . . . The inventor must inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.'"

The Court reaffirmed the public-interest aspect of section 112 in *Union Carbide Company v. Binny & Smith Co.*, 317 U.S. 228, 236 (1942):

> "A zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field."

Defendants contend that the term "apex", as used in sub-parts E and M of Claim 2, does not provide sufficient guidance to one skilled in the art to determine the precise strictures of the patent. Apex is defined in Webster's International Dictionary as: "The highest or uppermost point: as (1): the vertex of an angle, a cone, or a pyramid . . ." In the context of this case, the indefiniteness allegedly flows from the fact that "apex" could be interpreted to mean a sharp-line juncture of the upper and lower conical surfaces of the container or bottle finish, or could also include a radial juncture. A second source of difficulty is determining the precise magnitude of the radial juncture that would be wtihin the meaning of the term "apex."

In the light of these contentions, the first task of this Court is to determine the precise meaning, if any, of the term "apex" as used in the patent. There is nothing in the patent that would lead one to conclude that apex means a radial surface. On the contrary, common sense would indicate that the meeting point of two conical surfaces would be a point similar to the meeting point of two sides of a triangle, i.e., that in fact there was not a radial or curved surface between the two outermost points of the upper and lower conical surfaces.

Moreover, the Supreme Court in *Calmar, Inc. v. Cook Chem. Co.*, 383 U.S. 1, 33 (1965) indicated that the file-wrapper history of a patent should be considered in determining the proper construction of a patent. It is clear from the file-wrapper that Mr. Jesnig interpreted apex to mean a non-radial juncture. He characterized apex to mean a "peak or line," "knife edge," and "circular edge." It should be pointed out that these terms are not in the various claims that were filed during the period of prosecution, but are statements made before the Examiner. However, it would seem, and it has been long approved in this Circuit, that the inventor's statements are properly considered in interpreting the language of a patent claim. *Westinghouse Elec. Co. v. Hanover Chem. & Manu. Co.*, 179 F. 2d 293 (3rd Cir. 1949).

In sum, it is my opinion that the term apex as used in the claim is sufficiently definite to allow those skilled in the art to determine the scope of the patent. Common sense, and the inventor's own statements indicate that apex means a sharp-line juncture point of the upper and lower surfaces of the neck ring.

Section 102

Subsections (a) and (b) of section 102[2] spell out

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[2] *"Conditions for patentability; novelty and loss of right to patent*

the statutory standard of novelty. The critical date for the application of subsection (a) is the date of invention, and since I have found as a fact that Jesnig's date of invention was February 7, 1947, this is the reference point for section 102(a).

Ordinarily, the application date of the patent is the controlling point of reference under section 102(b). However, the defendants claim that the addition of elements E and M in the August 19, 1952 amendments constituted new matter under section 132. If this were the case, then August 19, 1952 would be the reference date under section 102(b). *See* 37 C.F.R. §1.118 (1967); *Muncie Gearworks, Inc. v. Outboard Marine & Manu. Co.*, 305 U.S. 759 (1942).

It is significant that the Patent Office made no objection to the amendments of August 1952. In view of this fact, this Court in making its own determination of this issue must give weight to the expert judgment of the Patent Office. *Technicon Instruments Corp. v. Coleman Instruments Corp.*, 385 F. 2d 391 (7th Cir. 1967); *Aerosol Research Co. v. Scovill Manu. Co.*, 334 F. 2d 751 (7th Cir. 1964). There was, however, a divergence of opinion in the expert testimony as to whether or not element M of '938 was new matter. I am persuaded that element M was not new matter, but rather was a description of the physical phenomenon that supposedly occurred when the cap was applied to the container. Since this explanation in no way changed the design or construction of the patented device, it could not be new matter. *See Technicon Instruments Corp. v. Coleman Instruments Corp.*, *supra*; *Aerosol Research Co. v. Scovill Manu. Co.*, *supra*; *Chemi-*

"A person shall be entitled to a patent unless—

"(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or . . ."

cal Const. Corp. v. Jones & Laughlin Steel Corp., 197 F. Supp. 644 (W.D.Pa. 1961), *aff'd*, 311 F. 2d 367 (3rd Cir. 1962). Therefore, the reference date for section 102 (b) is one year earlier than the application, September 2, 1948.

In order for the '938 patent to be invalidated under section 102(a) and (b), one prior art reference must show "all of the same elements . . . in exactly the same situation and united in the same way to perform the identical function." *Walker v. General Motors Corp.*, 362 F. 2d 56, 58 (9th Cir. 1966); *accord, Ceramic Tilers Supply, Inc. v. Title Council of America, Inc.*, 378 F. 2d 283 (9th Cir. 1967).

The defendants rely mainly on the Lumelite cap in combination with a crown finish, and the Kitchen Kap. However, neither of these products reads on the '938 patent in a sufficiently identical manner to invalidate the '938 patent. Also none of the other references that were extant during the appropriate time periods under section 102 (a) and (b) meets the stringent standard of identity required by section 102.

Section 103

As is typical in patent litigation, the defendants have strongly argued that the '938 patent is *obvious* within the meaning of section 103 of the Patent Act.[3] 35 U.S.C. §103. After section 103 was added in 1952, a controversy developed over the effect of the section on the standards of invention. However, the Supreme Court put this issue

[3] "*Conditions for patentability; non-obvious subject matter*

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

to rest in the *John Deere* trilogy.[4] Mr. Justice Clark, writing for the majority in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), stated:

> "We believe that this legislative history, as well as other sources, showed that the revision was not intended by Congress to change the general level of patentable invention. We conclude that the section was intended merely as a codification of judicial precedents embracing the *Hotchkiss* condition, with congressional directions that inquiries into obviousness of the subject matter sought to be patented are prerequisite to patentability."

The Supreme Court also indicated the factual analysis that a district court must make preparatory to applying the section 103 standard:

> "Under §103, the scope and content of the prior art are to be determined; diferences between the prior art and the claims at issue are to be ascertained; the level of ordinary skill and the pertinent art resolved. Against this background, the obviousness or unobviousness of the subject matter is determined." *Id.* at 17.

Since I have already determined the content of the prior art in my findings of fact, the primary point to consider is the difference between the prior art and the '938 patent.

Although seventeen patents were cited as prior art by the Examiner, the defendants have relied primarily on Stewart No. 2,109,805, and the British patent, No. 484,161. Jesnig No. 2,587,307, which was cited in the text of the patent by the inventor is also relied on by the defendants. Each patent discloses a different design of its neck

[4] *Graham v. John Deere Co.; Calmar, Inc. v. Cook Chem. Co.; Colgate-Palmolive Co. v. Cook Chem. Co.*, 383 U.S. 1 (1966); *United States v. Adams*, 383 U.S. 39 (1966). *See generally*, Kitch, *John Deere Co.: New Standards for Patents*, in The Supreme Court Review (Kurland ed. 1966).

ring. Stewart has an upper and lower conical surface with a radial juncture point. Jesnig '327 utilizes a standard finish which is semi-circular and the British patent specifies a "V" shaped neck ring which is to be made as sharp as possible. Both Stewart and the British patent use metal caps, whereas, the Jesnig '327 uses a polyethylene cap similar to that in the '938 patent.

Notwithstanding the marked similarity of the neck rings of Stewart and the British patents to the design of the '938 neck ring, and the substantial identity of the Jesnig '327 cap to the '938 cap, the Examiner granted the patent. The allowance of a patent claim gives rise to a presumption of validity under section 282 of the Patent Act.[5] 35 U.S.C. §282. The Third Circuit has recently indicated the effect of this presumption in *Schmidinger v. Welsh*, 383 F. 2d 455, 462, n. 10 (3rd Cir. 1967):

> "[T]he burden of proving invalidity in face of the presumption is a heavy one, but the presumption is by no means conclusive."

Moreover, the Supreme Court in the *John Deere* case observed that there is "a notorious difference between the standards applied by the Patent Office and by the courts." 383 U.S. at 18.

With the nature of the presumption in mind the next step is to analyze the references which were cited by the defendants in this litigation, but not cited by the Examiner. If these disclose relevant elements not before the Examiner, then the statutory presumption of section 282 is commensurately weakened. *Chemical Const. Corp. v. Jones & Laughlin Steel Corp.*, 311 F.2d 367 (3rd Cir. 1962); *Scripto Ink v. Ferber Corp.*, 267 F.2d 308 (3rd Cir.), *cert. denied*, 361 U.S. 861 (1959). On the other hand if there are no new elements in the defendants' references,

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[5] "*Presumption of validity; defenses*

"A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it. . . ."

then the presumption remains in effect, and this Court would be guided by the dictates of *Schmidinger*.

Goebel differs from '938 in that the neck ring originates below the mouth of the container. However, the design of the neck ring in Stewart and Goebel are the same, *i.e.*, an upper and lower conical surface with a radial juncture point. Also Goebel uses a metal cap somewhat akin to Stewart, but different from the elastomer cap of '938. However, the diameter of the metal cap at its narrowest point is slightly smaller than the diameter of the neck ring, and this is similar to the diameter of the '938 cap as it relates to the '938 finish. Goebel also indicates that the angles of the conical surfaces were deliberately designed to be abrupt, in order to enhance the locking effect as the cap engages the lower surface of the neck ring. The plaintiff's expert, Dr. Mauchly, testified that the abruptness of the angles was a significant aspect of '938.

Dunfee relates to a one-piece nipple and cap. The neck ring is "V" shaped, and, therefore, similar to the British patent cited by the Examiner. Engagement between the rubber cap is made on the lower conical surface and the container wall. In '938, no engagement is made on the wall, and the purpose of '938 was to have a snapoff cap, whereas, Dunfee endeavored to have the cap firmly secured to the bottle. However there is no indication that an adult could not remove the cap easily.

The plaintiff has challenged the propriety of considering Randlett as prior art. It will not be necessary to decide this point, since any relevant elements which Randlett discloses are also in proper prior art.

Defendants also cite the article "Precocious Plastics." This article predicted the advantageous use of polyethylene in the closure industry. It also pointed out that the Lumelite Corp. was presently marketing a polyethylene closure to be applied to soft-drink bottles having a standard crown finish. The defendants also cite the combination of a Lumelite cap and the British neck ring fin-

ish. There is a significant similarity between this combination and '038. However, the Examiner had the Lumelite cap and crown finish and the Lumelite cap and British finish before him, to the extent that Jesnig '327 and Sampson, No. 1,430,685, disclosed the use of plastic caps, Jesnig '327 disclosed the crown finish, and the British patent the "V" shaped finish.

Great reliance has been placed on the so-called Kitchen Kap and Flexeal finish manufactured by Owens-Illinois. The design of the polyethylene Kitchen Kap is somewhat similar to Jesnig '327 and '038. The upper surface of the Flexeal neck ring is different to the extent that its angle with the vertical is only 4°. This is in contrast to the abrupt angle of '038. It is the plaintiff's contention that this difference is critical in that the Flexeal finish will not expand the cap sufficiently to get the important tensioning effect. However, the Flexeal finish does have the abrupt angle on the bottom which is considered to be significant in '038.

Over the objection of plaintiff's counsel, the abandoned Barnby application, No. 759,019, was conditionally admitted into evidence. The defendants in their post trial brief have argued that the Barnby application represents an attempt by Owens-Illinois to obtain a patent on the Kitchen Kap. However, there is no testimony in the record to substantiate this position. Therefore, the Kitchen Kap cannot be equated to the cap and closure disclosed in the Barnby application.

Moreover, the plaintiff correctly argues that an abandoned patent application cannot be cited as a prior art reference. *White Cap Co. v. Owens-Illinois Glass Co.*, 203 F. 2d 694 (6th Cir. 1953). However, the Barnby application is relevant, since it is an indication of the state of art in the cap and closure field as of July 1947.

The Barnby application discloses the use of a polyethylene cap with an internal holding bead in the skirt, and the design of the neck ring is similar to the Owens-

Illinois Flexeal finish. Engagement is made between the cap bead and the lower surface of the neck ring; such engagement creates a "downward tension to the cap by which the latter is held in sealing contact with said top surface of the jar." One of Barnby's purposes was to create an air and vapor-tight seal without the use of gasket material between the top of the cap and the bottle mouth.

Barnby indicates that as early as July 1947, those skilled in the art were cognizant of benefits that could be realized by the use of polyethylene as the material for the manufacture of container caps. In addition, the use of a neck ring and an internal bead on the cap skirt were recognized as an advantageous means of utilizing the physical characteristics of polyethylene.

Plaintiff's case in chief consisted of only one witness, Dr. John W. Mauchly, a fully-qualified engineer. Dr. Mauchly was also the author of a lengthy affidavit that was submitted to the Patent Office in support of the patentability of the '938 patent. I will discuss his testimony at length, since it will be helpful in arriving at an understanding of the operation of the '938 device.

Initially, it should be pointed out that Dr. Mauchly testified to the effect that the specific design of the cap bead was not of great import. It was his position that the design of the neck ring was the essence of the inventive quality of '938.

Dr. Mauchly also indicated that the snapping sound which occurs when the '938 cap is applied to the container was not in itself of any significance, but rather, the snapping effect is a commercially advantageous by-product of the design of '938. He did stress two other effects of the design as being important; the sealing both at the mouth of the bottle and on the lower conical surface, and the fact that it was more difficult for the '938 cap to be improperly applied than caps and containers of different designs. Apparently, it is the double-sealing effect and the quality of

these seals, that constitutes the invention in the '938 patent.

As already pointed out, a neck ring is composed of an upper and lower surface and the juncture point of these two surfaces, called an apex in '938. The purpose of the neck ring is to interact with the cap in such a way as to take advantage of the physical characteristics of poly ethylene or some other resilient elastomer. It was Dr. Mauchly's position that the '938 patent disclosed the best way to utilize the qualities of a resilient elastomer cap.

Dr. Mauchly indicated that the most important aspect of the '938 neck ring was the design of the lower surface:

> "A reverse conical annular surface tapering abruptly on the side of the neck ring remote from the neck opening . . . ."

Two distinct features of the lower surface are covered by the above language: the lower surface is a straight line, and that line forms an abrupt angle with the vertical. The abrupt angle with the vertical is the key to the utilization of qualities of the elastomer cap. As the elastomer is stretched over the apex of the neck ring it is expanded, and a force develops in the cap to have it return to its normal position. The abrupt angle of the lower surface is designed to allow the cap to expend this developed force quickly, in what might be loosely described as similar to the release of a coiled spring.

In order to insure the quality of the seal on the lower surface, the length of the cap skirt must be designed so that the cap bead meets the lower surface in an appropriate position. If a semi-circular lower surface were used, manufacturing discrepancies might cause the cap to seal at a point on the circumference of the lower surface other than the intended point; this, in turn, could affect the sealing potential. The conical surface, on the other hand, minimizes the adverse effect of manufacturing variations, since the surface itself is a straight line, and, therefore, does

not have the inherent variations which a semi-circular surface would have.

The upper surface, which is also conical and abruptly tapered, is not as critical as the lower surface, in Dr. Mauchly's opinion. Expansion of the cap bead is the function of the upper surface, and either a semi-circular design, or some other design, will accomplish this purpose. However, the conical design is important to the extent that it requires a constant amount of force to be applied as the cap is moved down the upper surface, rather than a semi-circular surface which would require less pressure just above the apex than at points closer to the mouth of the bottle.

Design of the juncture of the upper and lower surfaces is not critical in relation to the sealing effect. The ideal design in Dr. Mauchly's opinion is that the juncture point or apex be as sharp as possible, but not so sharp as to damage the cap. If a radial-juncture surface is used, rather than a sharp-juncture point, it becomes possible for the cap to hang up on the radial surface. If the apex is sharp, then the transition from the upper to a lower-conical surface of the neck ring is achieved rapidly, and the amount of continuous force being applied to move the cap down the upper surface combined with the forces in the expanded cap results in springing the cap over the apex into its sealing position. The use of a radial surface, on the other hand, introduces a possible point where the cap might appear to be properly applied, when, in fact, it was not properly seated.

The only remaining aspect of '938 relates to the double seals and their quality. Dr. Mauchly's testimony, amplified in his affidavit, describes two forces at work: a radial and an axial force. As the cap is expanded over the neck ring, a radial force is created—the internal diameter of the cap bead expands and a resultant force develops to have the diameter return to its normal position. When the cap is seated, there is a radial force perpendicu-

lar to the vertical wall of the bottle causing the cap to grip the lower conical surface. Moreover, since the cap is a one-piece construction, as the cap head expands an axial force is created, forcing the top of the cap down onto the bottle mouth, and conversely on the lower surface there is an axial force in an upward direction forcing the head of the cap to contact the lower conical surface.

In sum then, Dr. Mauchly represented the '938 patent as the best possible design of a container and an elastomer cap. Unfortunately, this is not the precise issue of the case. Notwithstanding the engineering refinements of '938, in order for the patent to be valid, the disclosures of '938 must be found to be a non-obvious improvement over prior art. This court is, however, fully mindful of the often-articulated principle that simplicity does not bar patentability, and that care must be exercised to prevent hindsight from improperly coloring the determination of validity. *See* e.g., *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U.S. 428, 435 (1911).

In *Graham v. John Deere Co., supra* at 35-36, the Supreme Court indicated that certain pragmatic sub-tests are relevant in resolving the issue of non-obviousness. I have found as a fact that a need for improved closures existed in the pharmaceutical industry in 1948. I have also detailed the licenses granted under '938. The probative value of these licensing agreements is somewhat suspect; however, I do think it is appropriate to conclude that '938 did meet with moderate commercial success. There was no direct evidence on the third sub-test, viz., whether men skilled in the art had endeavored to solve the problem. All in all, the sub-tests favor patentability.

However, I am persuaded that this case falls into the same class as *Formal Fashions, Inc. v. Braiman Bros., Inc.*, 369 F.2d 536 (2nd Cir. 1966). There Judge Medina observed:

> "Appellant further offered the usual secondary evidence that the particular 'invention' before the

> court filled a long felt need . . . and had become a commercial success. But once it had been established by prior art references that the difference between the patent in suit and this prior art is . . . insubstantial . . . such secondary evidence cannot be held to demonstrate lack of obviousness." *Id.* at 539.

As to the use of polyethylene or other elastomer caps, it is clear that this is found in the prior art of Jesnig '327, the Lumelite cap, the Kitchen Kap, Sampson, and in the article entitled "Precocious Plastics."

Goebel and Stewart both show abruptly tapered conical surfaces forming the neck ring. They both have radial-juncture surfaces; however, the elimination of this feature would not render the '938 patentable. In fact, Dr. Mauchly indicated that there was merely a qualitative difference between a neck ring without a radial juncture and one with a radial juncture. Also, Goebel emphasizes the importance of having an abruptly-tapered lower surface for the same reasons as Dr. Mauchly.

The British patent describes a neck ring that is the same as '938. A "V" shaped neck ring as sharp as possible, is equivalent to saying abruptly tapered upper and lower conical surfaces. The Kitchen Kap also has an abrupt lower conical surface, although its upper surface has only a 4° angle. Also, Jesnig '327 was conceded by Dr. Mauchly to disclose the double sealing effect, although he did question the quality of the seal. The Kitchen Kap shows double sealing, with the cap and the mouth of the bottle, and the cap bead and the lower neck ring surface. Likewise, if the Lumelite cap were dimensionally coordinated with the British finish, a double sealing would be effectuated.

In sum, it is my conclusion, that taken as a whole, the '938 patent was obvious to one skilled in art. Therefore, it is my conclusion that the patent in suit, '938, is invalid under the standards of section 103.

INFRINGEMENT

The accused containers have a radial juncture between the upper and lower surfaces of the neck ring of 1/64 to 1/32 of an inch. I have also interpreted '938 to require a sharp-line juncture point of the upper and lower conical surfaces. Therefore, the issue is whether or not this structural difference is sufficient to preclude a finding of infringement.

Defendants' primary defense to infringement is that the accused structures cannot infringe because the doctrine of file-wrapper estoppel precludes this Court from reading the term "apex" to mean anything other than a sharp-line juncture. Under the doctrine of file-wrapper estoppel, a patentee who has limited a claim to circumvent a prior-art rejection by the Examiner is foreclosed from later claiming an interpretation which would effectively reinstate the element, or elements, previously eliminated. *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211 (1940); *Exhibit Supply Co. v. Ace Corp.*, 315 U.S. 126 (1942); *Chemical Construction Corp. v. Jones & Laughlin Steel Corp.*, 311 F.2d 367 (3rd Cir. 1962). If Mr. Jesnig substituted the term annular apex to avoid a prior-art rejection, then '938 should be read in this light.

I have already detailed in my findings of fact the transactions before the Examiner, and it is clear that on numerous occasions Mr. Jesnig distinguished his application from prior art on the basis that his neck ring had a sharp-line juncture. However, it is equally clear that the actual language of the final claim was not limited to avoid a prior-art rejection. Rather, the final claim and the original claim are the same, and the limited claims were submitted in the interim. Therefore, the doctrine of file-wrapper estoppel is not applicable.

This is not the end of the inquiry. It is now necessary to determine the effect of the doctrine of equivalents. In *Graver Tank & Manu. Co. v. Linde Air Products Co.*,

339 U.S. 605, 608 (1950), the Supreme Court articulated the appropriate standard:

> "[There is infringement] if [the accused structure] performs substantially the same function in substantially the same way to obtain the same result."

The plaintiff contends that under the standard of *Graver* the accused structures infringe. Dr. Mauchly, the plaintiff's expert, concluded that the accused structures had the same structural components and double seal as '938. He did, however, indicate that a radial juncture would affect the functioning of '938, and that this would be a less than ideal design. The defendants' expert emphasized the structural difference of the radial juncture, and the difference of the upper surface of some of the accused structures. Although much conflicting evidence was introduced as to the existence of element M of '938 in the accused structures, it is my opinion that, even if the accused structures had element M, infringement would not necessarily follow. The concern in this case is the design of the neck ring and cap and the resultant sealing effect.

Be all this as it may, in *Graver*, the Supreme Court also indicated that "equivalency must be determined against the context of the patent, the prior art and the particular circumstances of the case." 339 U.S. at 609. A particular application of the above principle that is pertinent here is *Lockwood v. Langendorf United Bakeries, Inc.*, 324 F.2d 82 (9th Cir. 1963). There the court observed:

> "[W]here . . . the art is fairly crowded and the main elements of the patent are found or indicated in prior art, this issue [equivalency] should be determined narrowly rather than liberally. If in fact, not merely colorably, the accused article de-

parts from the teaching of the patent in the means by which it achieves the result there is no infringement." *Id.* at 88.

It is clear that the approach taken by the *Lockwood* court is appropriate in this case. Looking at the '938 patent in light of Dunfee, Goebel, Stewart, the British patent, the Lumelite cap, the Kitchen Kap and the Flexeal finish, and the standard rounded finish, I am persuaded that the doctrine of equivalents is not properly applicable to result in a finding of infringement. The main elements of '938, the abrupt lower conical surface, the upper and lower conical surfaces in combination, and the polyethylene caps are all in the prior art. Also, the prior art disclosed upper and lower conical surfaces with a radial juncture. These were distinguished during the patent prosecution as being insufficient to achieve the invention. Moreover, the plaintiff's own expert indicated that the '938 patent was an improvement on prior art with the radial juncture.

It is true, as the plaintiff argues, that the use of a small radial juncture is a small quantitative difference. Yet, in the overall context of this case, the radial juncture also constitutes a qualitative difference between '938 and the accused structures.

CONCLUSIONS OF LAW

(1) This Court has jurisdiction over the parties and subject matter.

(2) Venue in this judicial district is proper.

(3) Plaintiff Package Devices, Inc. is the owner of United States Letters of Patent No. 2,020,938.

(4) Claim 2 of plaintiff's patent meets the requirements of validity under 35 U.S.C. §§101, 102.

(5) Claim 2 of plaintiff's patent is invalid under 35 U.S.C. §103.

(6) The accused structures do not infringe United States Letters No. 2,602,938.

ORDER

AND NOW, this 28th day of April, 1969, it is ORDERED that in Civil Actions Nos. 30984, 34333, 34334, 34483, judgment is entered in favor of the defendants, Sun Ray Drug Co., Owens-Illinois Glass Co., Wyeth Laboratories Division, American Home Products Corp., and E. J. Korvette, Inc.

/s/JOHN P. FULLAM, J.

JUDGMENT OF THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

Nos. 18,006, 18,007, 18,008, 18,009

ON APPEALS FROM THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF PENNSYLVANIA

Present: BIGGS, McLAUGHLIN and STALEY, *Circuit Judges*

JUDGMENT

These causes came on to be heard on the record from the United States District Court for the Eastern District of Pennsylvania and were argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of the said District Court, filed April 28, 1969, be, and the same is hereby affirmed, with costs taxed *in favor of appellees.*

ATTEST:

THOMAS F. QUINN,
Clerk

September 29, 1970

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IN THE

Supreme Court of the United States

October Term, 1970

Nos. ——

PACKAGE DEVICES, INC., *Petitioner*

v.

SUN RAY DRUG CO., *Respondent*

PACKAGE DEVICES, INC., *Petitioner*

v.

OWENS-ILLINOIS GLASS COMPANY, *Respondent*

PACKAGE DEVICES, INC., *Petitioner*

v.

WYETH LABORATORIES DIVISION
AMERICAN HOME PRODUCTS
CORPORATION, *Respondent*

PACKAGE DEVICES, INC., *Petitioner*,

v.

E. J. KORVETTE, INC., *Respondent*

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Petitioner, Package Devices, Inc. (Plaintiff and Appellant below), hereby petitions that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Third Circuit in the above action dated September 29, 1970, affirming the decision of the United States District Court for the Eastern District of Pennsylvania.

OPINIONS BELOW

The opinion of the Court of Appeals for the Third Circuit is reported at 167 U.S. P.Q. 193 (1970) and appears infra p. 11. In this opinion, Jesnig Patent 2,620,938 was found invalid. The decision of the District Court for the Eastern District of Pennsylvania is reported at 301 F. Supp. 738 (E.D. Pa., 1969).

The Jesnig patent was held invalid in the earlier opinion of the District Court for the Eastern District of Pennsylvania and affirmed by the Court of Appeals for the Third Circuit.

JURISDICTION

The jurisdiction of this Court is invoked under 28 U.S.C. Sec. 1254(1). The federal jurisdiction of the District Court was based on 28 U.S.C. 1338.

The Supreme Court has exercised jurisdiction in cases such as those where a Court of Appeals has rendered a decision in conflict with decisions of other courts of appeal on the same matter. Supreme Court Rule 19(1)(b).

QUESTIONS PRESENTED

Does Section 35 U.S.C. 102(b) containing the critical bar date of one year prior to the filing date of a patent application include the obviousness test set forth in Section 35 U.S.C. 103?

Can more than a single reference be used to invalidate a patent under 35 U.S.C. 102(b)?

Can a patent be invalidated under 35 U.S.C. 102(b) if the claimed invention is not identically disclosed or described in the prior art?

STATUTORY PROVISIONS INVOLVED

The questions to be decided all involve 35 U.S.C. 102(b) and 35 U.S.C. 103:

35 U. S. C. 102(b):

Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

35 U. S. C. 103:

Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. July 19, 1952, c. 950, §1, 66 Stat. 798.

Supreme Court Rule 19(1)(b):

"Considerations Governing Review on Certiorari

"1. . . . The following, while neither controlling nor fully measuring the court's discretion, indicate the character of reasons which will be considered"

"(b) Where a court of appeals has rendered a decision in conflict with the decision of another court of appeals on the same matter; . . ."

STATEMENT OF CASE

The petitioner (plaintiff and appellant below) is Package Devices, Inc., a Pennsylvania corporation and assignee of the patent in suit. Appellees and defendants below include various manufacturers and sellers of devices alleged to infringe the Jesnig patent in suit.

The Jesnig patent relates to a closure for such items as aspirin. A flexible cap is dimensioned to fit over and close the top of a bottle. At its neck opening, the bottle has a pair of conical surfaces coming to an apex. When it is on the bottle, a downward pull by the cap produces a sealing effect. A radial pressure by an inner ring of the cap against the bottom conical surface of the container produces a second sealing effect. The apex at the conical surfaces assures that the final position of the cap is either on or off and not in between.

The claim in suit is exemplified by products sold under the trademarks "Bufferin," "Excedrin" and other products.

The Lower Court (per Fullem, J.) found Section 102-(b) inapplicable because none of the references relied upon by defendants met the stringent standard of identity required by this section. However, the Lower Court dismissed the complaint and held that the Jesnig patent was invalid and not infringed.

The holding of invalidity was based on obviousness under 35 U.S.C. 103 and was made as a result of considering references which came into being after the date of the Jesnig invention. The holding of non-infringement was based on limiting the doctrine of equivalence because of prior art which also included references which came into being after the Jesnig invention. Consequently, both the holdings of invalidity and non-infringement by the District Court were based on consideration of references occurring after the Jesnig invention.

On appeal, the Court of Appeals for the Third Circuit

upheld the District Court in declaring the Jesnig patent invalid. However, it stated that the District Court did not apply the correct standard of law in basing its decision of invalidity on 35 U.S.C. 103. The Court of Appeals held that patentability was barred to Jesnig under Section 102(b). This holding of the Court of Appeals followed the case in Application of Foster, 343 F. 2d. 980 (CCPA 1965) cert. denied 383 U.S. 966 (1966). The Court of Appeals agreed with the District Court on the question of infringement.

In invalidating the Jesnig patent under 35 U.S.C. 102(b), the Court of Appeals for the Third Circuit stated that there were decisions in other Circuits seemingly contrary to its decision and the Application of Foster case.

REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT.

1. The decisional law in interpreting 35 U.S.C. 102(b) and 35 U.S.C. 103 is not certain or consistent, and the decision below is in conflict with decisions of other Courts of Appeals, namely the Ninth and Tenth Circuits, and the Court of Claims.

In *Walker v. General Motors Corp.*, 362 F. 2d 56, 58 (9 Cir. 1966) the Court of Appeals for the Ninth Circuit affirmed a lower Court's ruling of a summary judgment holding a Walker patent invalid on the grounds of obviousness under 35 U.S.C. 103. The Court of Appeals decided this after holding that granting of a summary judgment by the lower Court on the grounds of anticipation under 35 U.S.C. 102(b) was inappropriate. References relied upon were over two years prior to the filing date of the Walker patent.

In *Ceramic Tilers Supply, Inc. v. Tile Council of America Inc.*, 378 F. 2d 283, 284 (9 Cir. 1967) the Court of Appeals for the Ninth Circuit cited the *Walker v. General Motors Corp.* case (supra), stating:

> ". . . 'Unless all the same elements are found in exactly the same situation and united in the same way to perform the identical function' in a single prior art reference 'there is no anticipation.'".

The above decisions are in direct conflict with the holding of the Court of Appeals of the Third Circuit in the instant case regarding the interpretation of 35 U.S.C. 102(b).

The Court of Appeals for the Tenth Circuit held in *McCullough Tool Co. v. Well Surveys Inc.*, 343 F. 2d 381, 398 (10 Cir. 1965):

> ". . . In order for a prior patent to anticipate an invention, it is necessary that all the elements of the

> invention or their equivalents be found in one single structure or description, where they do substantially the same work in substantially the same way. . . ."

This decision of the Tenth Circuit is also in conflict with the holding of the Third Circuit in the instant case under petition.

The Court of Claims held in *Soundscriber Corp. v. United States*, 360 F. 2d 954, 960 (Ct. Cl. 1966):

> ". . . To constitute an anticipation, all the elements recited in the claim or their equivalents must be found in one unit of the prior art. . . ."

This decision of the Court of Claims is also in conflict with the holding of the Third Circuit in the instant case.

The wording of Statutes 35 U.S.C. 102(b) and 103 is clear. Section 35 U.S.C. 102(b) is a forfeiture statute in which a patent right is taken away from a person as a result of a subsequent happening, such as a public sale or use. Section 35 U.S.C. 103 involves a situation where, in fact, no patent right ever existed. Due process dictates a strict statutory interpretation of the forfeiture section 102(b), without adding conditions not already set forth in its wording.

There is no reason to assume that the Congressional intent as well as the codification of the old law are not represented by the present wording of Sections 102(b) and 103. "Anticipation" of a claimed invention always required that the basic concept involving the invention be found in a single reference, even when secondary references were used to show details not related to the basic concept.

While Section 35 U.S.C. 102(b) does not refer to identical disclosure, Section 35 U.S.C. 103 does. Section 35 U.S.C. 103 limits Section 102(b) to cases where the invention is "identically disclosed" without regard to whether the disclosure involved one or more references.

There has never been a public policy under the law before or after enactment of the present Patent Law in 1952 against an inventor proving his invention over patents having filing dates more than one year, in the absence of a statutory bar. Both before and after 1952, the filing date of a patent or copending application could be overcome by an affidavit alleging invention before the filing date of the patent or copending application. This was true even when the filing date was more than a year and the disclosure of such patent or copending application would have made obvious the invention claimed in the later application. The Patent Office follows this procedure today as evidenced by its Rule 131 (page 16).

The Patent laws include provisions to encourage early disclosure by an invention without the need to add penalties to Section 102(b). The likelihood of having his invention considered abandoned under the Patent Statutes would discourage an inventor from delaying filing his application. Also, the technological advances of our present society tend to encourage an inventor to file his application early.

CONCLUSION

Petitioner believes that it is important that all the Courts of Appeals interpret the statutes 35 U.S.C. 102(b) and 35 U.S.C. 103 in the same way. This is especially true in the case of 35 U.S.C. 102(b) which is a forfeiture statute dictating that due process be strictly employed before taking away an inventor's property right to a patent.

Wherefore your petitioner prays that a Writ of Certiorari issue to the Court of Appeals for the Third Circuit to the end that this cause may be reviewed and determined by the Court, that the judgment of the Court of

Appeals for the Third Circuit holding the Jesnig patent invalid be reversed.

Respectfully submitted,

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Attorneys for Plaintiffs-Appellants

OPINION OF THE U. S. COURT OF APPEALS FOR THE THIRD CIRCUIT

Argued June 15, 1970

Before BIGGS, MCLAUGHLIN and STALEY, *Circuit Judges*

(Filed September 29, 1970)

BIGGS, *Circuit Judge*.

The appeals at bar, four in number, concern themselves with the validity and infringement of Claim 2 of Jesnig's United States Patent No. 2,620,938 for the design of a container finish and a container cap. The patent was held invalid as obvious and also was held to be not infringed by the district court. 301 F.Supp. 768 (E.D. Pa., 1969). It is unnecessary to set out Claim 2 in this opinion for it is fully and correctly described *id. supra* 771-772. The substantial issue presented has never been ruled on directly by this court though possibly related dicta is to be found in the able opinion of Judge Weber of the United States District Court for the Western District of Pennsylvania in *Allen-Bradley Company v. Air Reduction Company*, 273 F.Supp. 930, 941 (1967), aff'd *per curiam* by this court, 391 F.2d 282 (1968). The appellant rests its case on an interpretation of Section 103, 35 U.S.C.,[1] declared by the United States

1. Section 102, 35 U.S.C., provides in part: "*Conditions for patentability; novelty and loss of right to patent.*

"A person shall be entitled to a patent unless—

"(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or . . ."

Section 103, 35 U.S.C., provides: "*Conditions for patentability; non-obvious subject matter.*

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this

Court of Customs and Patent Appeals in *Application of Palmquist*, 319 F 2d 547, at 551 (1963), which held that the time at which the determination of "invention" is to be made is "the time the invention was made" and that the principles established prior to the 1952 recodification of the patent laws apply to the determination of obviousness under Section 103, 35 USC. On the other hand, in *Application of Foster*, 343 F 2d 980 (1965), *cert. denied*, 383 US 906 (1966), decided approximately two years later, that Court held that where the time bar of Section 102(b) is involved the actual date of the invention becomes irrelevant and the applicant cannot dispose of a reference having a date more than one year prior to his filing date. By this decision the Court of Customs and Patent Appeals expressly overruled its holding in *Palmquist*.[2] 343 F 2d at 989. Such were the contrasting conclusions of the Court of Customs and Patent Appeals. In his opinion, however, the trial Judge in the instant case did not refer to either of the cited cases but seems to have based his conclusions strictly upon the provisions of Section 103, 35 USC, but used references which occurred after the date of Jessing's invention. The appellant contends that the conclusions of the trial court were erroneous and seems to have bottomed its appeal on the issue of the validity of the patent on the holding in *Palmquist*.

The facts can be stated briefly as follows. Jessing's invention date is February 4, 1947.[3] The date of filing of the '938 application was September 2, 1949, which would put the date of the statutory time bar at September 2, 1948.

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title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

2. The governing principle of *Application of Foster* is succinctly stated in the dissenting opinion of Judge Smith (who wrote the opinion in Palmquist), 343 F 2d at 989.

3. See Finding of Fact 9. Cf. Finding No. 11, 301 F. Supp. at 770.

The appellant points out that the district court considered at least nine references relevant to Jesnig's "invention" as part of the prior art. These references have dates between February 4, 1947 and September 2, 1948, inclusive, and are as follows: Sale of Lumelite Caps, Seagrams, after February 10, 1947;[4] July 1947, sale of Kitchen Cap with Flexeal Finish, July 1947 filing date of abandoned Barnby application;[5] sale of Lumelite Caps, Seagrams, October 1947, February 1948, publication "Precocious Plastics";[6] May 1948, filing date of previous Jesnig Patent No. 2,576,416, after May 1, 1948, sale of Lumelite Caps (Kroger),[6] and June 1948, filing date of Randlett Patent No. 2,576,416. No one of the listed references completely disclose the Jesnig invention, but the trial Judge concluded that in the aggregate they rendered the Jesnig invention obvious. We agree.

If the standard of *Foster* is correct, the district court did not err in considering the foregoing items but if the test of *Palmquist* is applied, as contended for by the appellant the District Judge should have excluded all the items referred to in the preceding paragraph from his consideration.[7] The issue presented for our determination, therefore, on this phase of the instant case is the point of time from which obviousness must be observed. The appellees contend that it is clear that the deci-

4. It would appear from the record, however, that the Lumelite Caps, Seagrams, were sold as early as 1945. The point, however, is unimportant in view of our decision.

5. The Barnby application was in no wise relied on by the district court as part of the prior art but was expressly rejected in the Court's consideration, and rightly so. 301 F. Supp. at 779.

6. Four publications including "Precocious Plastics" were considered by the District Judge.

7. The parties are agreed, as indeed they must be, both citing the Deere trilogy (*Graham v. John Deere Co.*, 383 U.S. 1, 12-17 (1966)), that non-obviousness is a necessary condition for patentability and that this was made a statutory requirement by the 1952 Patent Act which codified a principle originally enunciated by the Supreme Court in 1851 in *Hotchkiss v. Greenwood*, 11 How. 248.

sion in *Foster* is correct, relying principally on the theory that the phrase "at the time the invention was made" was included in the 1952 statute to preclude the use of hindsight in deciding whether or not the invention is obvious.

Section 103, 35 U.S.C., speaks of a patent being obvious at the time of the invention date. Section 102(b) teaches that patents are invalid if published or described more than one year prior to the date of the patent application, *i.e.*, there is a time bar of one year. *Foster* puts the obviousness test of Section 103 by implication into Section 102(b).

The district court in the case at bar correctly held, in substance, that the differences between the prior art and the claimed invention is to be determined by "the level of ordinary skill in the pertinent art", citing *Graham v. John Deere Co.*, 383 U.S. 1 (1966). It is clear, however, that *Foster* permits a multiplicity of prior art references which, added together, demonstrate obviousness. As stated previously there are prior art references published more than one year prior to the date of Jesnig's invention. If the doctrine of *Foster* be applied the patent at bar would be invalid for want of patentability if, as we have held, the references to the prior art, hereinbefore specifically referred to, constitute obviousness. As we have indicated the contrary would be the case if the *Palmquist* doctrine of a single reference be employed. At the risk of needless repetition and for the sake of clarity, we reiterate that what *Foster* teaches is that Section 102(b) containing the critical bar date of one year prior to the patent application as the time for determining patentability implicitly contains the obviousness test of Section 103. We believe that *Foster* was correctly decided and we deem it unnecessary to elucidate the facts of *Foster* and the reasoning of Judge Almond. We find his opinion to be clear and convincing, particularly when read in the light of the concurring and dissenting opinions and we think that we can add no cogency to it. Applying the *Foster* doctrine, we find that the Jesnig's invention was not patentable. We conclude that

the District Court in bottoming its decision on Section 103 did not apply the correct standard of law but that it did reach the right result. We therefore hold Claim 2 of the patent in suit invalid on the ground that patentability was barred to Jesnig under Section 102(b) for the reasons stated.[8]

We think it unnecessary to write on the issue of infringement. We find the reasoning and the conclusion of the District Court to be correct.[9]

The judgment of the district court will be affirmed.

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8. There are, of course, decisions seemingly contrary to *Application of Foster* in other Circuits. See *Walker v. General Motors Corp.*, 362 F.2d 56, 58 (1966); *Ceramic Fibers Supply Co. v. Tile Council of America, Inc.*, 378 F.2d 284 (9 Cir. 1967); *McCullough Tool Co. v. Well Surveys, Inc.*, 343 F.2d 381, 398 (10 Cir. 1965), and *Spindelfiber Corp. v. United States*, 360 F.2d 954, 960 (Ct. Cl. 1966).

9. In view of our decision we find it unnecessary to deal with any issue that could be raised by Jesnig 2,587,327, cited in the text of the patent in suit. See 301 F. Supp. at 770 and 778. The contentions of the appellees as to the disclosures of this patent are not clear.

A True Copy:

Teste:

Clerk of the United States Court of Appeals for the Third Circuit

PATENT OFFICE RULE 131

Affidavit or declaration of prior invention to overcome cited patent or publication.

(a) When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath or declaration as to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, then the patent or publication cited shall not bar the grant of a patent to the applicant unless the date of such patent or printed publication be more than one year prior to the date on which the application was filed in this country.

(b) The showing of facts shall be such, in character and weight as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

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IN THE

Supreme Court of the United States

October Term, 1970.

No. 1141

PACKAGE DEVICES, INC., *Petitioner,*

vs.

SUN RAY DRUG CO., *Respondent.*

PACKAGE DEVICES, INC., *Petitioner,*

vs.

OWENS-ILLINOIS GLASS COMPANY, *Respondent.*

PACKAGE DEVICES, INC., *Petitioner,*

vs.

WYETH LABORATORIES DIVISION AMERICAN HOME PRODUCTS CORPORATION, *Respondent.*

PACKAGE DEVICES, INC., *Petitioner,*

vs.

E. J. KORVETTE, INC., *Respondent.*

BRIEF FOR RESPONDENTS IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI.

J. HAROLD KILCOYNE,
ARTHUR RAICH,
JOHN J. McALEESE, JR.,
JOHN R. NELSON,
Attorneys for Respondents.

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E. J. KORVETTE, INC., *Respondent.*

BRIEF FOR RESPONDENTS IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

This is an ordinary patent suit. Petitioner charged Respondents with infringement of claim 2 of the Jesnig patent 2,620,938, issued December 9, 1952, upon an application filed September 2, 1949. The patent in suit is directed to the combination of a bottle and a rubber or plastic snap cap therefor, the alleged improvement residing primarily in the shape of the neck ring of the bottle over which the cap snaps. The single claim at issue is found in the Appendix,* pages 5 and 6, and is precisely and concisely analyzed by the District Court on pages 12 and 14 of the Appendix.

PETITIONER PRESENTS NO CASE OR CONTROVERSY BUT ONLY SEEKS AN ADVISORY OPINION WITH RESPECT TO 35 U. S. C. 102(b) AND THE VALIDITY OF ITS PATENT.

The District Court found that the Owens-Illinois accused structure bottle finishes all have a radius of 1/64 to 1/32 of an inch at the juncture of the upper and lower surfaces of the neck ring. (App. 10.)

To determine the meaning of the term "apex", the District Court painstakingly examined the prosecution file history of the patent in suit, as set forth in Findings of Facts 17 through 22 (App. pages 3-5), and found:

> "It is clear from the file wrapper that Mr. Jesnig interpreted apex to mean a non-radial juncture. He characterized apex to mean a 'peak or line,' 'knife edge,' and 'circular edge.' * * *.

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* The Appendix bound to the Petition is referred to herein as "Pet. App." and Petitioner's other separate Appendix containing the opinion, and judgment of District Judge Fullam and the judgment of the Court of Appeals for the Third Circuit is referred to herein as "App.".

> "* * * Common sense, and the inventor's own statements indicate that apex means a sharp-line juncture point of the upper and lower surfaces of the neck ring." (App. 14.)

The District Court also carefully analyzed the testimony of plaintiff's expert, Dr. Mauchly (App. 21-24), and then concluded that claim 2 at issue was not infringed. (Conclusion of Law 6, App. 29.) This finding of non-infringement was affirmed on appeal. (Plaintiff's Pet. App. 15, 432 F. 2d 272.)

Infringement is a question of fact, *Williams Manufacturing Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364, 86 L. Ed. 1537 (1941); *Stilz* v. *United States*, 269 U. S. 144, 70 L. Ed. 202 (1925).

Thus, at the outset we are confronted with concurrent findings of the District Court and the Court of Appeals that the claim in issue is not infringed.

As this Court said in *Graver Tank & Manufacturing Co.* v. *Linde Air Products Co.*, 366 U. S. 271, 275, 93 L. Ed. 672, 677 (1948):

> "A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error." (Citations omitted.)

No such showing is made by Petitioner. The opinion of the District Court with its numerous findings of fact and careful analysis of the prior art and the testimony of plaintiff's expert witness, Dr. Mauchly, shows that there was substantial evidence to support the finding that the claim in issue was not infringed.

Petitioner does not seek a review of the Court of Appeals for the Third Circuit's affirmance of the District Court's

conclusion that claim 2 in issue is not infringed but prays only:

> "that the judgment of the Court of Appeals for the Third Circuit holding the Jesnig patent invalid be reversed." (Petition, pages 9, 10.)

Thus, there is no longer any controversy between the parties to this litigation, *Cover* v. *Schwartz*, 133 F. 2d 541 (2nd Cir. 1942). As this Court has said:

> "To hold a patent invalid if it is not infringed is to decide a hypothetical case." *Altvater* v. *Freeman*, 319 U. S. 363, 87 L. Ed. 1453 (1942).

Since this controversy has been terminated by the judgments and the concurrent findings of the District Court and the Court of Appeals that the claim in issue is not infringed, there is no need for this Court to review and rule on the issue of validity.

Further, the issue of infringement is not raised by the questions Petitioner has presented for review and, hence, this issue should not be considered by this Court, Rules of the Supreme Court of the United States, Rule 23(c).

THE DECISION OF THE COURT OF APPEALS FOR THE THIRD CIRCUIT IS NOT IN CONFLICT WITH THE DECISION OF ANY OTHER CIRCUIT AND IN FACT IS IN AGREEMENT WITH THE DECISION OF THE COURT OF CUSTOMS AND PATENT APPEALS ON THE SAME MATTER.

In holding claim 2 in issue invalid under 35 U. S. C. 103, the District Court considered prior art patents, publications and public uses having effective dates prior to Jesnig's date of invention* and also prior art publications

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* Circuit Judge Biggs took note of this stating:

> "As stated previously there are prior art references published more than one year prior to the date of Jesnig's invention." (Pet. App. 14.)

and public uses having effective dates more than a year before the Jesnig application for the patent in suit was filed but subsequent to Jesnig's invention date. (App. 25.) The Court of Appeals for the Third Circuit held that the District Court did not err by considering all of the prior art references in concluding that the patent in suit was invalid but that the District Court in bottoming its decision on 35 U. S. C. Section 103 did not apply the correct standard of law but reached the right result. The Court of Appeals apparently concluded that under Section 103 obviousness must be determined "at the time the invention was made" but it held the patent in suit invalid under Section 102(b) containing the critical bar date of one year prior to the patent application and used that date as the time for determining patentability by the obvious—non-obvious test.

The Court of Appeals held the patent in suit invalid under Section 102(b) and based its decision on the principles enunciated in *Application of Foster*, 343 F. 2d 980 (C. C. P. A. 1965), certiorari denied 383 U. S. 966 (1966): namely, that where the one year time bar of 35 U. S. C. Section 102(b) is involved, which is the case here, in determining the obviousness of the invention the actual date of the invention of the patent in suit becomes irrelevant and a reference having a date more than one year prior to the applicant's filing date is effective even though the invention was made prior to the date of the reference. The Court of Appeals for the Third Circuit held that Section 102(b) implicitly contains the obvious—non-obvious test of Section 103. (Pet. App. 14.) Thus construing Section 102(b) the Court of Appeals agreed with the District Court that the prior art rendered the Jesnig invention obvious and not patentable. (Pet. App. 13.)

Petitioner contends that Section 102(b) does not provide for invalidation of a patent where the invention is not

completely disclosed in a single prior art patent, publication, or public use and where a plurality of references are necessary to show want of patentable invention or the obviousness of the purported invention to a person having ordinary skill in the art to which the invention pertains. Prior to *Application of Palmquist, et al.*, 319 F. 2d 547 (C. C. P. A. 1963), the United States Court of Customs and Patent Appeals had consistently held that a plurality of references may be used in rejecting a claim for a patent under Section 102(b) where the references were published more than a year before the application even though the date of invention of the subject matter sought to be claimed was prior to such publications. *In re Wenzel*, 88 F. 2d 501 (C. C. P. A. 1937); *Application of Ruscetta*, 255 F. 2d 687 (C. C. P. A. 1958); *Ex parte Austin*, 72 USPQ 384 (Patent Office Board of Appeals, 1946).

In *Application of Palmquist et al., supra*, the Court held that only a single reference may be used to show the loss of a right to a patent and that under Section 103 the obviousness of the invention must be determined at the time the invention was made and not at a time one year before the application was filed. *Application of Palmquist et al.* thus enunciated new law and upon a more careful consideration of the *Palmquist* decision the Court of Customs and Patent Appeals in *Application of Foster, supra*, overruled *Application of Palmquist et al.* and clearly held that a reference having a publication date more than one year prior to the United States filing date to which the application was entitled cannot be disposed of by date of invention earlier than the date of the reference. 343 F. 2d 989. In *Application of Foster*, the Court speaking through Judge Almond, carefully reviewed the decisional law prior to the 1952 Patent Act which is represented to be a codification of the prior decisional law and concluded that:

> "where the time-bar is involved, *the actual date of invention becomes irrelevant* and that it is not in accordance with either the letter or the principle of the law, or its past interpretation over a very long period, to permit an applicant to dispose of a reference having a date more than one year prior to his filing date by proving his actual date of invention." (343 F. 2d 989.)

As Circuit Judge Biggs in commenting on the Palmquist doctrine stated:

> "We believe that *Foster* was correctly decided and we deem it unnecessary to elucidate the facts of *Foster* and the reasoning of Judge Almond. We find his opinion to be clear and convincing, * * *." (Pet. App. 14.)

The interpretation of Section 102(b) in *Application of Foster, supra*, has been followed consistently in the United States Court of Customs and Patent Appeals, *Application of Folkers*, 344 F. 2d 967 (C. C. P. A. 1965); *Application of Hasxler*, 347 F. 2d 911 (C. C. P. A. 1965).

Petitioner would have this Court believe that an inventor after making an invention could withhold it from the public as long as he pleased even though the invention had become obvious subsequent to the date of invention but more than a year before his application for a patent by a single reference plus the skill of the art involved or by a plurality of references such as printed publications and public uses. As Judge Almond stated in *Application of Foster*, 343 F. 2d at 990:

> "The wrong in such a construction of the statute—beside giving it a meaning that was never intended—is that it permits an inventor to sleep on his rights more than a year after the invention has become entirely obvious to the public, whereby the public has potential possession of it, and still obtain a patent which will take the invention from the public, a result Con-

gress could not possibly have intended in view of its express indication that section 102(b) is merely a continuation of the prior law."

Petitioner has cited no cases contrary to *Application of Foster, supra*, but contends that the decision below is in conflict with *Walker* v. *General Motors Corp.*, 362 F. 2d 56, 58 (9th Cir. 1966); *Ceramic Tiles Supply, Inc.* v. *Tile Council of America Inc.*, 378 F. 2d 283, 284 (9th Cir. 1967); *McCullough Tool Co.* v. *Well Surveys, Inc.*, 343 F. 2d 381, 398 (10th Cir. 1965); *Soundscriber Corp.* v. *United States*, 360 F. 2d 954, 960 (Ct. Cl. 1966).

None of these cases involve the fact situation present in this case and in *Foster;* namely, that the prior art or references relied upon in finding the patent in suit invalid contained references having effective publication or prior use dates more than one year before the application for the patent in suit was filed but subsequent to the invention date of the patent in suit. The Court in each case had before it references having effective dates prior to the invention date of the patent in suit and more than one year prior to the filing date of the application for the patent in suit and thus bottomed their decisions on Section 103.

The Walker Case.

The *Walker* case is inapposite to the *Application of Foster* because the question presented did not involve an invention date by plaintiff Walker earlier than the French publication which disclosed all the elements of the Walker patent. In the French reference, the fender and gas tank were constructed as an integral unit. Of the three claims in the suit, claim 3 was held invalid on grounds of anticipation 35 U. S. C. 102(b); however, claims 1 and 2 were drawn to the separate unit construction of fender and tank and a question arose as to equivalency. The Court said:

> "Since the issue of equivalence could not be determined without resolving these disputed questions of fact, we conclude that as to claims 1 and 2 summary judgment on the grounds of anticipation was not appropriate." (362 F. 2d 58.)

Plaintiff accepted the fact that the French reference was prior art as to the Walker patent. The issue of the law suit did not involve whether or not the French reference was an anticipation of claims 1 and 2 under Section 102(b) but rather whether this issue could be decided on motion for summary judgment. The Court held that it could not be decided on summary judgment and then proceeded to hold claims 1 and 2 invalid for obviousness under Section 103.

The Soundscriber Case.

In the *Soundscriber* case one of the defenses raised to the complaint related to the prior work of one Camras, which work was prior to the date of invention of the claim at issue. This raised the defense that:

> "the alleged invention defined in claim 6 of the '449 patent is invalid because it had been known to or used by others in this country prior to the invention thereof;" (360 F. 2d at 957.)

Soundscriber thus presented the question of *novelty* under Section 102(a) whereas *Foster* dealt with loss of right to a patent, Section 102(b).

Ceramic Tilers Case.

Ceramic Tilers is distinguishable from *Foster* because the prior art Spillman patent relied upon as an anticipation was not questioned as being prior to the time of the making invention of the patent in suit. The Spillman reference was qualitatively attacked as it was not complete enough

to anticipate and evidence taken at the trial was insufficient to evaluate the obviousness question under Section 103 so the case was remanded to the lower Court.

The McCullough Tool Case.

In *McCullough Tool* in considering the defense that the Pringle patent was nothing more than an aggregation of elements old in the art and thus comes within the rules of the *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 95 L. Ed. 162 (1950), the Court stated:

> "Of course, to establish *anticipation* in such a situation, it is not necessary that all of the elements be found in a single patent or publication. It is enough if the whole of the prior art considered together discloses all of the claimed elements and that no new functional relationship arises from their combination." (Italics supplied.) (343 F. 2d 398.)

McCullough clearly distinguishes between anticipation, a Section 102 defense, and the obvious—non-obvious defense of Section 103 and in so doing definitely holds that anticipation can be established by a plurality of prior art patents or publications.

Thus not one of the four decisions relied upon by Petitioner presented the factual situation present in this case; namely, that the combination of prior art references relied upon to invalidate the patent in suit had effective bar dates more than one year before the application for the patent in suit but subsequent to the invention date and thus were not concerned with the ruling made by Judge Biggs here and previously in *Foster* and the other cases cited; namely, that such references are effective under Section 102(b) which implicitly contains the obvious—non-

obvious test. The questions raised by the petition were never reached in these four decisions in the factual context of the present case.

Petitioner would have this Court believe that the 1952 Patent Act changed the prior decisional patent law which it has been consistently represented to codify and would remove from the prior art any reference which does not completely show every element of the claim at issue and where the reference has a date subsequent to the invention date of the patent in suit even though the reference was public knowledge and in the public domain more than a year before the application for the patent in suit was filed. The practice in the Patent Office has always been to the contrary. The present Patent Office Rule 131 (Pet. App. 16) and its predecessor Rule 75 (footnote 8, 343 F. 2d 987) have always provided that an applicant for a patent cannot swear back of and remove a reference published more than a year before the application filing date even though the applicant's invention date was prior to the publication of the reference.

"Anticipation" is not found in either Sections 102 or 103 of the Patent Act. Petitioner states (Pet. p. 8):

> "'Anticipation' of a claimed invention always required that the basic concept involving the invention be found in a single reference, even when secondary references were used to show details not related to the basic concept."

Thus Petitioner admits that "anticipation" can be supported by secondary references. The only purpose of secondary references would be to combine them with the principal reference to show that the subject matter of the claim at issue involved differences that were such a slight advance over the prior art that they were insufficient to support a patent, *International Tooth Crown Co.* v. *Gay-*

lord, 140 U. S. 55, 62, 35 L. Ed. 347, 350 (1890), or merely involved

> "the work of a skillful mechanic, not that of the inventor." *Hotchkiss* v. *Greenwood*, 11 How. 248, 267, 13 L. Ed. 683, 691 (1850).

Petitioner states:

> "Section 35 U. S. C. 103 limits Section 102(b) to cases where the invention is 'identically disclosed' without regard to whether the disclosure involved one or more references." (Pet. p. 8.)

Here again Petitioner admits that a plurality of references can be used in invalidating under Section 102(b). Section 102(b) does not refer to "identical disclosure", while Section 103 does. To read this limitation of Section 103 into Section 102(b) does not make sense and leads only to confusion. This Court has ruled that the "prior art" referred to in Section 103 means:

> "what was known before as described in section 102." *Graham* v. *John Deere Co.*, 383 U. S. 1, 15, 15 L. Ed. 2d 545, 555 (1966).

If, as Petitioner contends, Section 102(b) requires as a condition for lack of patentability a single reference containing an identical disclosure to that of the claim at issue, that is, all the same elements found in exactly the same situation and united in the same way to perform the identical function, then there would be no differences between the subject matter sought to be patented and the prior art of Section 102 as defined above by this Court and Section 103 becomes meaningless. Thus, one cannot read the limitation "identically disclosed" of Section 103 into Section 102(b) without leading to hopeless confusion and ambiguity. Section 103 clearly indicates that there may be differences between the claim at issue and the prior art encompassed by Section 102 and thus the principle of the

Foster case and that followed by Judge Biggs; namely, that Section 102(b) implicitly contains the obvious—non-obvious test, is supported rather than rejected by the wording of Section 103.

The paucity of decisions since *Application of Foster* involving its factual situation and the ruling thereon shows that there is here presented no question of public importance. This Court denied a Petition for Writ of Certiorari in *Application of Foster*.

CONCLUSION.

Since Petitioner presents no case or controversy and the decision below follows the ruling in *Application of Foster* and is not in conflict with decisions of other Courts of Appeals, the Petition for Writ of Certiorari should be denied.

Respectfully submitted,

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Attorneys for Respondents.

The question of infringement is directly related to the questions presented by Petitioner

Respondents contend that "the issue of infringement is not raised by the questions Petitioner has presented for review and, hence, this issue should not be considered by this Court. . . ." (Respts. Br. 4). Petitioner disagrees with this contention.

Petitioner stated in the Petition

> ". . . The holding of non-infringement was based on limiting the doctrine of equivalence because of prior art which also included references which came into being after the Jesnig invention. Consequently, both the holdings of invalidity and non-infringement by the District Court were based on consideration of references occurring after the Jesnig invention" (Pet. App. 5).*

The District Court held

> ". . . Looking at the '938 patent in the light of Dunfee, Goebel, Stewart, the British patent, the Lumelite cap, the Kitchen Kap and the Flexeal finish, I am persuaded that the doctrine of equivalence is not properly applicable to result in a finding of infringement" (App. 28).

Drawings for the Kitchen Kap were in existence on April 10, 1947 and the Kitchen Kap was sold in July 1947 (Finding of fact 37, App. 9). The District Court also held that the Jesnig invention was February 7, 1947, which was prior to the Kitchen Kap-Flexeal finish combination (App. 15).

Most of the testimony presented by Respondents during the trial related to the Kitchen Kap-Flexeal finish combination. It is reasonable to assume therefore that

*"App. Pet." will refer to Petitioner's "Petition," which included part of the Appendix. "App." will refer to separate binder entitled "Appendix to Petition."

the District Court gave much weight to this combination. If this combination is inapplicable, then the District Court and the Court of Appeals erred in refusing to allow any range of equivalence and holding non-infringement.

The question of infringement, therefore, is directly related to the questions raised by the Petitioner.

The Court of Appeals for the Third Circuit did not discuss the issue of infringement except to say that it found the reasoning and conclusion of the District Court to be correct (Pet. App. 15).

There is no file wrapper estoppel

Respondents refer to statements of the District Court regarding the meaning of the word "apex," which appears in Claim 2 of the Jesnig patent (Respts. Br. 2, 3).

In addition to the parts quoted by Respondents, the District Court also held

> ". . . However, it is equally clear that the actual language of the final claim was not limited to avoid a prior art rejection. Rather, the final claim and the original claim are the same, and the limited claims were submitted in the interim. Therefore, the doctrine of file wrapper estoppel is not applicable" (App. 26).

In the absence of file wrapper estoppel, Petitioner contends than the word "apex" should be given its ordinary meaning.

The Jesnig invention was not "identically disclosed" in any combination of prior art references

Respondents stated that Petitioner contended that Section 102(b) requires as condition of patentability a single reference containing an identical disclosure to that of the claim at issue (Respts. Br. 12). While this is involved

in the second question presented by the Petitioner (Pet. App. 3), it is not the issue with respect to the third question.

The important point in the third question is: after all the applicable references are combined, is the *invention* "identically disclosed"? Whether two, three or a dozen references are relied upon is not important as far as the third question is concerned. Petitioner contends that the Jesnig inventive concept covered by his claim involves a positive on-off action of a cap with respect to a container, together with a double dynamic sealing effect between the cap and container. This concept was not shown or suggested in the applicable prior art even if multiple references are combined. Section 102(b) is therefore inapplicable.

Petitioner in effect is presenting two questions in the alternative in the second and third questions (Pet. App. 3). If either the second or third question is answered in the affirmative, then the Jesnig patent should be considered valid and infringed.

Respectfully submitted,

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